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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/020,515 | 12/07/2001 | Guy G. Riddle | 18602-06587 | 8767 |
| 61520 | 7590 | 10/23/2007 | EXAMINER | |
| APPLE/FENWICK | | | LIN, KENNY S | |
| SILICON VALLEY CENTER | | | ART UNIT | PAPER NUMBER |
| 801 CALIFORNIA STREET | | | 2152 | |
| MOUNTAIN VIEW, CA 94041 | | | | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/020,515 | RIDDLE, GUY G. | |
| | Examiner | Art Unit | |
| | Kenny Lin | 2152 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 08 August 2007.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-16 and 21-46 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-16 and 21-46 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.



Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date <u>8/8/2007</u> | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| | 6) <input type="checkbox"/> Other: _____ |

'DETAILED ACTION

1. Claims 1-16 and 21-46 are presented for examination. Claims 17-20 are canceled.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8/8/2007 has been entered.

3. The IDS submitted on 8/8/2007 is considered.

4. The reissue oath/declaration filed with this application is defective because it fails to contain the statement required under 37 CFR 1.175(a)(1) as to applicant's belief that the original patent is wholly or partly inoperative or invalid. See 37 CFR 1.175(a)(1) and see MPEP § 1414. The declaration fails to state the reason of a defective specification or drawing, or of patentee claiming more or less than patentee had the right to claim in the patent regarding to claims 21-46.

5. Claims 1-16 and 21-46 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

The nature of the defect(s) in the declaration is set forth in the discussion above in this Office action.

6. Claims 16 and 21-46 are rejected under 35 U.S.C. 251 as being improperly broadened in a reissue application made and sworn to by the assignee and not the patentee. A claim is broader in scope than the original claims if it contains within its scope any conceivable product or process which would have infringed the original patent. A claim is broadened if it is broader in any one respect even though it may be narrower in other respects.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claims 21-46 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Nowhere in the specification disclosed the claimed step of “said first entity *multicasting* a request message to said plurality of second entities over a communication channel...”. The specification disclosed to *broadcast* a request message to said plurality of second entities. One of ordinary skill in the art would have understood that “multicasting” and “broadcasting” are different.

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9. Claims 27 and 40 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Nowhere in the specification disclosed the claimed step of “selecting a multicast address which is used for said act of multicasting the request message”. The specification disclosed the use of multicast address, but did not disclose that the multicast address is “selected”. In order to select a multicast address, there must first exist a group of multicast address for the first entity to choose from. Since the specification did not disclose to first having a plurality of multicast addresses, it would not have suggested to select one address from a pool of many addresses.

10. Claims 28 and 41 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Nowhere in the specification disclosed the claimed step of “determining whether each of said plurality of second endpoints is coupled to said first endpoint via a communication medium”. The specification disclosed that each second endpoint is coupled to the first endpoint via a communication medium. However, the specification did not disclose to “determine” the existence of a communication medium between the first endpoint and each second endpoint.

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11. Claims 31-32 and 44-45 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Nowhere in the specification disclosed the claimed step of “first message and second messages are both transmitted before the act of multicasting” nor “first message and second message are both transmitted before establishing said point-to-point mode” (first message and second message comprises respective capabilities; see claims 29-30 and 42-43). The specification disclosed that the capabilities of the endpoints are exchanged prior to setting up a conference. However, the specification did not show that the conference is using multicasting or point-to-point mode. Further, setting up a conference after the exchange of capabilities is very different from the “act of multicasting” or “establishing point-to-point mode” since the act of multicasting or establishing of point-to-point mode may not necessary considered as part of the conference, but rather, acts of preparation before the conference.

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 21-26, 29-30, 33-39, 42-43 and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Alvarez, III et al (Alvarez), US 4,507,781, in view of Auerbach et al (Auerbach), US 5,355,371.

14. Alvarez and Auberbach were cited in the 1/7/2003 IDS.

15. As per claims 21, 33-34 and 46, Alvarez discloses in a system wherein a first entity and a plurality of second entities in a network are operating in a point-to-point mode, with each of said second entities connected by a point-to-point communication channel with said first entity (fig.1, col.4, lines 22-24, col.3, lines 53-62). Alvarez further discloses communication in multipoint mode (conferencing, col.4, lines 1-6). Alvarez does not explicitly discloses when the system is switched to the multipoint mode the point-to-point mode is disabled. However, since the import intranodal buffers are set to the same partition, this disables the ability of the intranodal buffer to participate in duplex communication.

16. Alvarez does not disclosed when communicating in the multipoint mode, the first endpoint activating a multicast channel, transmitting a request message and receiving acknowledgements. However, in an analogous art, Auerbach discloses in a system wherein a first entity and a plurality of second entities in a network are operating in a point-to-point mode, with each of said second entities connected by a point-to-point communication channel with said first entity (fig.4), an automatic method for optimizing a mode of transmission of data between said plurality of second entities and said first entity, the method comprising the following steps:

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- a. Said first entity multicasting a request message to said plurality of second entities over a communication channel, said request message being used to initiate transition from said point-to-point mode to a multicast mode (col.8, lines 40-43);
- b. Said first entity receiving from certain of said plurality of second entities an acknowledgement message in response to said request message, said acknowledgement message indicating that each of said certain of said plurality of entities was able to receive said multicast request message (col.8, lines 43-49).

17. It would have been obvious to one of ordinary skill in the art to combine the teachings of Alvarez and Auerbach to implement a system where a first endpoint can activate a multicast communication channel, and having the first endpoint query the second endpoints to see if they are able to receive multicast, using acknowledgement responded by the second endpoints, and then disable the point-to-point communication channel in order to setup multicast communication routes independent of the control, configuration and administration of an operator (Auerbach, col.2, lines 38-41).

18. As per claims 22-23 and 35-36, Alvarez and Auerbach did not specifically teach that the acknowledgement message includes a response code. However, the use of response code in messages is well known and expected in the art. It would have been obvious to one of ordinary skill in the art at the time the invention was made to include response code in message indicating whether the receiving end can response to it or not.

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19. As per claims 24 and 37, Alvarez and Auerbach did not specifically teach that the data comprises audio data and video data. However, the transmission of audio and video is well known and expected in the art (For example, Dangi et al, US 5,231,492, cited by the applicant in the 8/8/2007 IDS discloses audio and video transmission).

20. As per claims 25 and 38, Auerbach further discloses to operate each of said certain of said plurality of second entities in a multicast mode (col.8, lines 40-49).

21. As per claims 26, and 39, Auerbach further discloses, for any of said plurality of second entities which do not send an acknowledgement, continuing to operate said first entity in a point-to-point mode with such non-acknowledging second entities (col.9, lines 10-13).

22. As per claims 29-30 and 42-43, Auerbach further discloses said first entity transmitting a first message comprising capabilities of said first entity to at least a portion of said plurality of second entities; said second entities transmitting a second message comprising respective capabilities of said at least a portion of said second entities to first entity substantially in response to said first entity transmitting said first message (col.8, lines 40-49: required information and response).

Conclusion

23. A shortened statutory period for reply to this Office action is set to expire THREE MONTHS from the mailing date of this action.

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24. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kenny Lin whose telephone number is (571) 272-3968. The examiner can normally be reached on 8 AM to 5 PM Tue.-Fri. and every other Monday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bunjob Jaroenchonwanit can be reached on (571) 272-3913. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



ksl

October 20, 2007